

REMARKS

In the Office Action mailed November 26, 2007 (hereinafter, "Office Action"), claims 30 and 31 stand rejected under 35 U.S.C. § 112. Claims 1-3, 7-9, 11-13, 17-19, 21-25, 27 and 30-33 stand rejected under 35 U.S.C. § 102. Claims 4-6, 10, 14-16, 20, 26, 28 and 29 stand rejected under 35 U.S.C. § 103. Claims 1, 11, 21, 27, 30 and 32 have been amended. Claim 34 has been added.

Applicants respectfully respond to the Office Action.

I. Claims 30-31 Rejected Under 35 U.S.C. § 112

Claims 30-31 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 has been amended according to the Office Action's suggestion. Specifically, Claim 30 has been amended such that the request to support communications with a packet-network is received by a "second base station controller in the packet-switched network." Applicants respectfully request that the rejection of claim 30 be withdrawn.

Because the rejection of claim 31 was based on dependence from claim 30, Applicants respectfully request that the rejection of claim 31 be withdrawn for at least the same reasons as those presented above in connection with claim 30.

II. Claims 1-3, 7-9, 11-13, 17-19, 21-25 and 27 Rejected Under 35 U.S.C. § 102

Claims 1-3, 7-9, 11-13, 17-19, 21-25 and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,560,239 to Frid et al. (hereinafter, "Frid"). Applicants respectfully traverse.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition,

“the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 1 has been amended to recite “providing a filtering mechanism capable of determining a format type of the received message.” Support for this amendment may be found in Applicants’ specification, for example, page 9, paragraph [0036]. Frid does not disclose this subject matter.

Instead Frid states:

In an exemplary embodiment, a wireless subscriber activates a call-waiting-type service along with an option to retain a packet-switched data communication. Thereafter, the subscriber may be engaged in a data communication on a packet data channel of the wireless communications system.

Frid, Abstract.

Activating a call-waiting-type service does not disclose “providing a filtering mechanism capable of determining a format type of the received message.” Similarly, providing an option to retain a packet-switched data communication does not disclose “providing a filtering mechanism capable of determining a format type of the received message.” Frid further states “[a]cceptance of a subsequent incoming, circuit-switched voice call causes the data packet session to be suspended.” (Id.) Merely disclosing that incoming voice calls are accepted does not disclose “providing a filtering mechanism capable of determining a format type of the received message.”

Frid also states:

The present invention provides a method and system for implementing a call-waiting-type service in which packet data communications may be retained upon interruption and quickly restored thereafter. The packet data communication retention call-waiting feature may be activated by the subscriber on either a permanent or a per-call basis. A retention activation request is preferably transmitted by a requesting mobile station (MS) as a packet data connection is initially being established.

Frid, col. 2, lines 30-40.

Activating the “packet data communication retention call-waiting feature” on a permanent or a per-call basis does not disclose “providing a filtering mechanism capable of determining a format type of the received message.” Instead, determining whether or not the

activation disclosed in Frid is activated is based on whether or not the call-waiting feature is implemented for every voice call or on a per voice call basis.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Frid. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn because Frid does not disclose all of the subject matter of claim 1.

Claims 2-3 and 7-9 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-3 and 7-9 be withdrawn.

Claims 11, 21 and 27 have been amended with subject similar to the subject matter amended to claim 1. As such, Applicants submit that claims 11, 21 and 27 are patentably distinct from Frid for at least the same reasons as those presented above in connection with claim 1.

Claims 12-13 and 17-19 depend either directly or indirectly from claim 11. Claims 22-25 depend either directly or indirectly from claim 21. Accordingly, Applicants respectfully request that the rejection of claims 12-13, 17-19 and 22-25 be withdrawn.

III. Claims 30-33 Rejected Under 35 U.S.C. § 102

Claims 30-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0145987 to Carlsson et al. (hereinafter, “Carlsson”). Applicants respectfully traverse.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, “the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 30 has been amended to recite “providing a filtering mechanism capable of determining a format type of the received message.” Support for this amendment may be found

in Applicants' specification, for example, page 9, paragraph [0036]. Carlsson does not disclose this subject matter.

Instead Carlsson states:

Base station 115 may provide mobile terminal 110 with circuit-switched services on an air interface 125 which may comprise, for example, a 30 kHz bandwidth air interface. Base station 120 may provide mobile terminal 110 with packet data services on air interface 130 which may comprise, for example, a 200 kHz bandwidth air interface. Voice or data may be transmitted across interfaces 125 and 130 in accordance with, for example, the EGPRS-136 (or GPRS) standard. Base station 145 may provide mobile terminal 140 with circuit-switched or packet-switched services on an air interface 125 which may comprise, for example, a 30 kHz bandwidth interface. Voice data may be transmitted across interface 125 in accordance with the TIA/EIA-136 or TIA/EIA-41 (ANSI-41) standards.

Carlsson, paragraph [0023].

Providing a mobile terminal with circuit-switched services and packet data services does not disclose "providing a filtering mechanism capable of determining a format type of the received message." Similarly, providing a mobile terminal with circuit-switched or packet data services does not disclose "providing a filtering mechanism capable of determining a format type of the received message."

Carlsson also states:

Serving MSC/VLR 205 may include circuitry for controlling circuit calls to/from the mobile terminal 110 and other devices and for connecting those calls to the PSTN 160. Gateway MSC/VLR 210 may control circuit-related signaling to/from the mobile terminal 110 during those periods when mobile terminal 110 is camped on a packet channel.

Carlsson, paragraph [0026].

Controlling circuit calls to/from the mobile terminal does not disclose "providing a filtering mechanism capable of determining a format type of the received message." In addition, connecting those calls to the PSTN does not disclose "providing a filtering mechanism capable of determining a format type of the received message." Similarly, controlling circuit-related signaling to/from the mobile terminal during those periods when mobile terminal is camped on a packet channel does not disclose "providing a filtering mechanism capable of determining a format type of the received message."

Carlsson further states:

The GPRS HLR 230 may include one or more databases that store and manage subscriber data for a subscriber's packet data services. Upon interrogation by SGSN 220, GPRS HLR 230 may provide packet data subscription-related information. Upon interrogation by the GGSN 225, GPRS HLR 230 may provide routing information for the indicated subscriber. GGSN 225 may include circuitry for connecting packet data sessions between the mobile terminal 110 and PDN 165.

Carlsson, paragraph [0027].

Storing and managing subscriber data for a subscriber's packet data services does not disclose “providing a filtering mechanism capable of determining a format type of the received message.” Further, providing packet data subscription-related information does not disclose “providing a filtering mechanism capable of determining a format type of the received message.” In addition, providing routing information for the indicated subscriber does not disclose “providing a filtering mechanism capable of determining a format type of the received message.”

In addition, Carlsson states:

To begin processing, mobile terminal 110 or 140 may perform a packet control channel reselection operation in which the mobile terminal 110 or 140 switches from one packet control channel to another. This reselection process may occur, for example, as a result of mobile terminal 110 or 140 being moved to a new location . . . Mobile terminal 110 or 140 then may determine if EGPRS-136 is preferred over GPRS as the packet-data service for the mobile terminal [step 810] . . . If so, mobile terminal 110 or 140 determines if EGPRS-136 service is available in the current radio communications cell [step 815]. If not, processing continues at step 825 below. If EGPRS-136 service is available, mobile terminal 110 or 140 attaches to the EGPRS-136 packet-data service using the EGPRS-136 control channel in accordance with conventional techniques [step 820].

Carlsson, paragraph [0050].

Performing a packet control channel reselection operation in which the mobile terminal switches from one packet control channel to another does not disclose “providing a filtering mechanism capable of determining a format type of the received message.” Instead, the reselection process occurs as a result of mobile terminal being moved to a new location. Determining if EGPRS-136 is preferred over GPRS as the packet-data service for the mobile terminal also does not disclose “providing a filtering mechanism capable of determining a format type of the received message.” Further, determining if EGPRS-136 service is available in the

current radio communications cell does not disclose “providing a filtering mechanism capable of determining a format type of the received message.”

In view of the foregoing, Applicants respectfully submit that claim 30 is patentably distinct from Carlsson. Accordingly, Applicants respectfully request that the rejection of claim 30 be withdrawn because Carlsson does not disclose all of the subject matter of claim 30.

Claim 31 depends directly from claim 30. Accordingly, Applicants respectfully request that the rejection of claim 30 be withdrawn.

Claim 32 has been amended to include subject matter similar to the subject matter of claim 30. As such, Applicants submit that claim 32 is patentably distinct from Carlsson for at least the same reasons as those presented above in connection with claim 30.

Claim 33 depends directly from claim 32. Accordingly, Applicants respectfully request that the rejection of claim 33 be withdrawn.

IV. Claims 4-6, 10, 14-16, 20, 26, 28 and 29 Rejected Under 35 U.S.C. § 103

Claims 4-6, 10, 14-16, 20, 26, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Frid in view of Carlsson. Applicants respectfully traverse.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int’l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references “must teach or suggest all the claim limitations.” M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection “should be made explicit.” KSR, 2007 U.S. LEXIS 4745, at **37. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Claims 4-6 and 10 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 4-6 and 10 be withdrawn.

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Claims 14-16 and 20 depend either directly or indirectly from claim 11. Accordingly, Applicants respectfully request that the rejection of claims 14-16 and 20 be withdrawn.

Claim 26 depends directly from claim 21. Accordingly, Applicants respectfully request that the rejection of claim 26 be withdrawn.

Claims 28 and 29 depend either directly or indirectly from claim 27. Accordingly, Applicants respectfully request that the rejection of claims 28 and 29 be withdrawn.

V. New Claim 34

Claim 34 has been added. Applicants submit that claim 34 is fully supported by Applicants' specification. Claim 34 includes subject matter similar to the subject matter described hereinabove in relation to claim 1. As such, Applicants submit that claim 34 is patentable for at least the same reasons as those previously described.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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